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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,685	08/10/2001	Lachlan Everett Hall	NPI003US	6901

7590 06/08/2005

KIA SILVERBROOK  
393 Darling Street  
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AUSTRALIA

EXAMINER

POWERS, FIONA

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/927,685	HALL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Fiona T. Powers	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-5 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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Claims 1 to 5 are drawn to more than one patentably distinct (under 35 U.S.C. 121) area of invention, joined together via means of "Markush" type claims, and accordingly, election of a single species (chosen from infrared dye molecules of structure 3 to 7 on page 87) is required as per the provisions of MPEP 803.02.

The claims as presented contain such a vast multitude of possible compounds due to the "possibilities and permutations" that are present that it is not possible to identify each and every species encompassed by the claims. Accordingly, to facilitate election, applicants are required to elect a single specific compound and upon such election the Examiner will review the claims and indicate (a) which compounds are so similar thereto as to be part of the elected matter and, (b) by such indication (i.e. by exclusion) which compounds are drawn to non-elected subject matter. Further, whatsoever compounds are treated together so too will compositions containing such active compound(s) also be part of the elected subject matter. With the election of a specific exemplified compound, a inventive concept, including the corresponding composition will be identified by the examiner as the inventive group for the examination.

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It is considered that the "Markush" type claims encompassing such species are directed to multiple independent and distinct inventions since the species encompass compounds that are so unrelated and diverse that a prior art reference anticipating the claims with respect to one of the species will not render the claims obvious under 35 U.S.C. 103 with respect to any of the other species. Further, these claims encompass species that are considered to be independent since they are unconnected in operation, one does not require the others for ultimate use and the specification does not disclose a dependent relationship between them. Moreover, there are encompassed species that are considered to be distinct from others on the basis of their properties. Thus, this application contains species that are capable of supporting separate patents under 35 U.S.C. 121.

Accordingly, applicants are now required to make a provisional election of a single independent and distinct species of compound as noted supra, prior to the examination of said claims on the merits. This election will be given the effect in the event that the Markush type claim(s) is (are) not found allowable, at which time the examination of the claims presented will be limited to the Markush type claim(s) directed solely to the elected species, with claims directed to the

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nonelected species being held withdrawn from further consideration. It should be noted that an election of species has been held to be tantamount to a requirement for restriction (In re Herrick, 1958 C.D. 1 and In re Joyce, 1958 C.D. 2) and enjoys the benefit of 35 U.S.C. 121.

Applicants' response must include a provisional election even though the requirement be traversed (37 CFR 1.142 and 1.143). Applicants are also advised that any traversal must be supported by specific argument(s) in order to perfect the right to petition in the event that the provisional requirement is given effect in the event noted supra. Applicants are also advised that arguments adequate to cause withdrawal of this requirement would warrant the ultimate conclusion that all species are patentably indistinct and a reference for one species would be considered a reference as to all species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Fiona T. Powers*  
Fiona T. Powers  
Primary Examiner  
Art Unit 1626

ftp  
June 1, 2005